

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD J. PETRUS

Appeal No. 2003-2002
Application No. 09/444,660

ON BRIEF

MAILED

JUL 21 2004

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before MCQUADE, BARRETT, and NASE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Edward J. Petrus appeals from the final rejection of claims 1 through 5, all of the claims pending in the application.¹

THE INVENTION

The invention relates to a method of creating a dietary supplement profile for an individual. Representative claim 1 reads as follows:

1. A method/process of creating a dietary supplement profile for an individual comprising:
 - a) completing a health questionnaire by an individual,
 - b) comparing of the questionnaire information by an individual to an optimal health profile in a computer data base,

¹ Claims 2 and 3 have been amended subsequent to final rejection.

- c) adjusting for differences in the individual's health information when compared to an optimal health profile,
- d) generating a computer-implemented dietary supplement profile based on the individual's health information listing the vitamins, minerals, amino acids, enzymes, and herbs suggested for an optimal health profile.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Summerell et al. (Summerell)	5,937,387	Aug. 10, 1999
Riley	5,976,568	Nov. 2, 1999

THE REJECTION

Claims 1 through 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Summerell in view of Riley.

Attention is directed to the main and reply briefs (Paper Nos. 17 and 21) and to the answer (Paper No. 20) for the respective positions of the appellant and the examiner regarding the merits of this rejection.²

² In the final rejection (Paper No. 8), claims 2 and 3 also stood rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The examiner has since withdrawn this rejection in light of the amendment of claims 2 and 3 subsequent to final rejection (see the advisory action dated November 18, 2002, Paper No. 10).

DISCUSSION

I. Preliminary matters

The appellant (see pages 1 through 5 in the main brief) raises as issues in the appeal the propriety of (1) the examiner's decision to make "final" the Office action appealed from (Paper No. 8), and (2) the Technology Center Director's decision (Paper No. 12) to deny the appellant's 37 CFR § 1.181 petition (Paper No. 11) requesting withdrawal of the finality of such Office action. As these related matters are not directly connected with the merits of issues involving a rejection of claims, they are not reviewable by appeal to this Board (see In re Hengehold, 440 F.2d 1395, 1403-04, 169 USPQ 473, 479 (CCPA 1971)), and hence will not be further addressed in this decision.

II. The appealed rejection

We shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1 through 5 as being unpatentable over Summerell in view of Riley. For the reasons expressed below, claims 1 through 5 are indefinite. Therefore, the standing prior art rejection must fall since it necessarily is predicated on speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our decision in

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this regard rests solely on the indefiniteness of the claimed subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the § 103(a) rejection.

III. New rejections

The following new rejections are entered pursuant to 37 CFR § 1.196(b).

Claims 1 through 5 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.

Id.

As indicated above, independent claim 1 recites a method/process of creating a dietary supplement profile of an

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individual comprising, inter alia, the steps of comparing an individual's health questionnaire information to an "optimal health profile" in a data base and "adjusting" for differences in the individual's health information when compared to the "optimal health profile." Read in light of the underlying disclosure, these recitations of the "optimal health profile" and the "adjusting" step render the scope of claim 1, and claims 2 through 5 which depend therefrom, indefinite. The underlying disclosure makes no mention of an "optimal health profile," and instead describes comparison of the questionnaire information to "a health profile for a person of the consumer's age and health history background" (specification, page 2) and/or to "standardized profiles based on age, sex, physical activity, dietary habits, past medical history and other items covered in the questionnaire" (specification, page 3). Neither of these descriptions reasonably depicts an "optimal health profile" or gives any indication as to what an "optimal health profile" might be. Similarly, the underlying specification makes no mention of any type of "adjusting" step corresponding to that recited in claim 1.

The scope of dependent claims 2, 3 and 4 is additionally indefinite in that it is unclear whether the recitations in

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claims 2 and 3 of "a health profile in a computer database" and in claim 4 of "an optimal health profile" refer to the "optimal health profile" recited in parent claim 1 or to some other health profile. With further regard to claim 4, the recitation of "the dietary supplements listed in an optimal health profile" is confusing in light of the description in the underlying specification that the dietary supplements are listed in the dietary supplement profile rather than in an optimal health profile.

Claims 1 through 5 also are rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which lacks a written description of the claimed invention.

The test for determining compliance with the written description requirement of the first paragraph of 35 U.S.C. § 112 is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

In the present case, the disclosure of the application as originally filed would not reasonably convey to the artisan that

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the appellant had possession at that time of a method/process of creating a dietary supplement profile of an individual comprising the steps of comparing questionnaire information to an "optimal health profile" in a data base and "adjusting" for differences compared to the "optimal health profile" as now recited in independent claim 1, or the step of providing "the dietary supplements listed in an optimal health profile" as now recited in dependent claim 4. As alluded to above in connection with the § 112, ¶ 2, rejection, the original disclosure makes no mention of an "optimal health profile," an "adjusting" step or the provision of "dietary supplements listed in an optimal health profile."

SUMMARY

The decision of the examiner to reject claims 1 through 5 is reversed, and new rejections of these claims are entered pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

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37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
- (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b).

John P. McQuade
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